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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN C. WREN

Appeal 2008-2765
Application 08/650,834
Technology Center 3600

Decided: ¹March 31, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN and JOSEPH A. FISCHETTI, Administrative Patent Judges.

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 (2008), begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or the Notification Date (electronic delivery).

1 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection
2 of claims 30-36, 38-45, 47-54, 57-64, 67-116, and 121-143. We have
3 jurisdiction under 35 U.S.C. § 6(b) (2002).

4 Appellant invented a system and means for establishing a
5 communicating link between remote facilities (Specification 1:12-13).

6 Independent claim 30 under appeal read as follows:

7 30. An apparatus to market and/or sell goods
8 and/or services over an electronic network
9 comprising:

10 a first computerized central communications
11 facility adapted to be linked to a computerized
12 remote facility and to a plurality of other
13 computerized central communications facilities,
14 each of said first or other computerized central
15 communications facilities having information
16 relating to goods or services stored in a database,
17 and each of said first or other computerized central
18 communications facilities having a processor
19 programmed to:

20 receive from a customer located at said
21 computerized remote facility a request to at least
22 one of search, browse and access in said database
23 at said first or other computerized central
24 communications facility for information of
25 interest;

26 enable said customer to at least one of
27 search, browse and access said database for
28 information of interest; and

29 transmit said information of interest from
30 the database at said computerized central
31 communications facility to said computerized
32 remote communications facility;

wherein at least one of said computerized central communications facilities is adapted to provide to said customer at said computerized remote facility a list of computerized central communications facilities permitting said customer to select and contact at least one other computerized central communications facility to request additional information relating to said goods or services.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Dworkin	US 4,992,940	February 12, 1991
McCalley et al.	US 5,191,410	March 2, 1993
Filepp	US 5,347,632	September 13, 1994
Lockwood	US 5,576,951	November 19, 1996
Gifford	US 5,724,424	March 3, 1998
Saigh et al.	US 5,734,823	March 31, 1998
Ferguson et al.	US 5,819,092	October 6, 1998
Wren	US 6,055,514	April 25, 2000

ATT Services: AT&T provides compass, Communications International, London, July 1993, Vol. 20, Iss. 7, p. 6, 2 pages (hereinafter “AT&T”).

InTouch Internet Shopping Network (ISN) launches Interactive Home Music Shopping Service with intouch group, inc. for Internet Users Worldwide; online service features more than 40,000 music titles in 21 genres. Business Wire, 11 April 1995 (hereinafter “InTouch”).

The Examiner rejected claims 115, 116, 121, 122 and 140-143 under 35 U.S.C. § 102(e) as being anticipated by Saigh; claim 123 under 35 U.S.C. § 102(e) as being anticipated by Gifford; claims 30-33, 36, 39-45, 47, 49, 51, 54, 57-64, 67, 79-85, 87-90, 92 and 100 under 35 U.S.C. § 103(a) as being

1 unpatentable over AT&T in view of Dworkin; claims 50, 72, 77, 78 and 86
2 under 35 U.S.C. § 103(a) as being unpatentable over AT&T in view of
3 Dworkin and McCalley; claims 34, 35, 38, 48, 52, 53, 68, 69, 94, 95, 103
4 and 107 under 35 U.S.C. § 103(a) as being unpatentable over AT&T in view
5 of Dworkin and Filepp; claims 70-76 under 35 U.S.C. § 103(a) as being
6 unpatentable over AT&T in view of Dworkin and McCalley; claims 93, 96-
7 98, 101 and 104-106 under 35 U.S.C. § 103(a) as being unpatentable over
8 AT&T in view of Dworkin and Examiner's Official Notice; claims 108,
9 110-114 and 139 under 35 U.S.C. § 103(a) as being unpatentable over
10 Saigh in view of Lockwood; claim 109 under 35 U.S.C. § 103(a) as being
11 unpatentable over Saigh in view of Lockwood and Ferguson; claim 139
12 under 35 U.S.C. § 103(a) as being unpatentable over Saigh in view of
13 Lockwood; claim 124 under 35 U.S.C. § 103(a) as being unpatentable over
14 Saigh; claim 125 under 35 U.S.C. § 103(a) as being unpatentable over
15 Gifford in view of Ferguson; claims 126 under 35 U.S.C. § 103(a) as being
16 unpatentable over Gifford in view of Lockwood; claims 127-129 under
17 35 U.S.C. § 103(a) as being unpatentable over Gifford in view of Saigh;
18 claims 130-132 and 135-137 under 35 U.S.C. § 103(a) as being unpatentable
19 over Saigh in view of Kaplan/InTouch; claim 133 under 35 U.S.C. § 103(a)
20 as being unpatentable over Saigh in view of InTouch and Ferguson; claim
21 134 under 35 U.S.C. § 103(a) as being unpatentable over Saigh in view of
22 Lockwood; claim 138 under 35 U.S.C. § 103(a) as being unpatentable over
23 Saigh in view of Ferguson; claim 30 under the judicially created doctrine of
24 obviousness-type double patenting as being unpatentable over Wren in
25 view of AT&T and Dworkin; and claims 108-114 and 130-143 under the

1 judicially created doctrine of obviousness-type double patenting as being
2 unpatentable over Wren in view of Saigh, Ferguson, InTouch, and
3 Lockwood.

4

5 **SUMMARY OF THE DECISION**

6 We affirm the rejections of claims 30, 31, 33-36, 38, 40, 42-45, 47-52,
7 57, 59-68, 70-94, 96-102, 104-107, 123 and 126.

8 We reverse the rejections of claims 32, 39, 41, 53, 54, 58, 69, 95, 103,
9 108-116, 121, 122, 124, 125, and 127-143.

10 We also use our authority under 37 C.F.R. § 41.50(b) to enter two
11 new grounds of rejection: (1) claims 53, 95 and 103 are rejected under
12 35 U.S.C. § 103(a) as being unpatentable over AT&T, Dworkin and Filepp;
13 and (2) claims 93 and 101 are rejected under 35 U.S.C. § 103(a) as being
14 unpatentable over AT&T and Dworkin.

15

16 **PRINCIPLES OF LAW**

17 *Filing Date*

18 The applicant for a United States patent bears the burden of
19 establishing its entitlement to the filing date of a previously filed application.
20 *Wagoner v. Barger*, 463 F.2d 1377, 1380 (CCPA 1972).

21 In order for a reference to claim an effective filing date of an
22 application to which it claims priority under 35 U.S.C. § 102(e), the
23 application must disclose, pursuant to §§120/112, the invention claimed in
24 the reference. *In re Wertheim and Mishkin*, 209 USPQ 554, 565-566
25 (C.C.P.A. 1981).

1 *Written Description*

2 The written description requirement of 35 U.S.C. § 112, ¶ 1, is
3 straightforward: The specification shall contain a written description of the
4 invention To satisfy this requirement, the specification must describe
5 the invention in sufficient detail so that one skilled in the art can clearly
6 conclude that the inventor invented the claimed invention as of the filing
7 date sought. *In re Alonso*, 545 F.3d 1015, 1019 (Fed. Cir. 2008).

8

9 *Claim Construction*

10 During examination of a patent application, a pending claim is given
11 the broadest reasonable construction consistent with the specification and
12 should be read in light of the specification as it would be interpreted by one
13 of ordinary skill in the art. *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d 1359,
14 1364 (Fed. Cir. 2004).

15 While the specification can be examined for proper context of a claim
16 term, limitations from the specification will not be imported into the claims.
17 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir.
18 2005).

19 A preamble is not limiting where a patentee defines a structurally
20 complete invention in the claim body and uses the preamble only to state a
21 purpose or intended use for the invention. *Catalina Mktg. Int'l, Inc. v.*
22 *Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Rowe v.*
23 *Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)).

24

25

1 *Obviousness*

2 The test for obviousness is not whether the features of a secondary
3 reference may be bodily incorporated into the structure of the primary
4 reference; nor is it that the claimed invention must be expressly suggested in
5 any one or all of the references. Rather, the test is what the combined
6 teachings of the references would have suggested to those of ordinary skill
7 in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

8 Once a prima facie case of obviousness is established, the burden
9 shifts to Appellant to rebut it. *Id.*

10 One cannot show non-obviousness by attacking references
11 individually where the rejections are based on combinations of references.
12 *Id.*

13

14 *Analogous Art*

15 A reference is analogous art if it is either in the field of the applicant's
16 endeavor or reasonably pertinent to the particular problem with which the
17 inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir.
18 1992). In addition, when a work is available in one field of endeavor, design
19 incentives and other market forces can prompt variations of it, either in the
20 same field or a different one. For the same reason, if a technique has been
21 used to improve one device, and a person of ordinary skill in the art would
22 recognize that it would improve similar devices in the same way, using the
23 technique is obvious unless its actual application is beyond his or her skill.
24 *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007).

25

1 *Related Applications*

2 Examiners are not bound to follow other examiners' interpretations.

3 *Dayco Products Inc. v. Total Containment Inc.*, 329 F.3d 1358, 1368 (Fed.
4 Cir. 2003).

5

6 *Official Notice*

7 To adequately traverse a finding of Official Notice, the Appellant
8 must specifically point out the supposed errors in the Examiner's action,
9 which would include stating why the noticed fact is not considered to be
10 common knowledge or well-known in the art. A general allegation that the
11 claims define a patentable invention without any reference to the Examiner's
12 assertion of Official Notice is inadequate. In the absence of any demand
13 by Appellant for the Examiner to produce authority for his statement, the
14 traversal shall not be considered. *In re Chevenard*, 139 F.2d 711, 713
15 (CCPA 1943).

16

17 *Printed Matter*

18 Where the printed matter is not functionally related to the substrate,
19 the printed matter will not distinguish the invention from the prior art in
20 terms of patentability. *In re Gulack*, 703 F.2d 1381, 1386-86 (Fed Cir.
21 1983).

22

23 *Citing References*

24 Where a reference is relied on to support a rejection, whether or not in
25 a "minor capacity," there would appear to be no excuse for not positively

1 including the reference in the statement of rejection. *In re Hoch*, 428 F.2d
2 1341, 1342 n. 3 (CCPA 1970).

3

OPINION

5 Rejection of claims 115, 116, 121, 122, and 140-143 under
6 35 U.S.C. § 102(e) as being anticipated by Saigh.

7 The sole issue in regard to this rejection is whether the Appellant
8 has shown that the Examiner erred in asserting that Saigh is prior art to the
9 subject matter of claims 115, 116, 121, 122, and 140-143 because parent
10 Application No. 08/268,309 filed June 29, 1994 (hereinafter the “309
11 application”) does not provide written description support for multiple
12 central communications facilities.

13 *Findings of Fact*

14 The ‘309 application discloses an array of central facilities that
15 communicate with each other and a remote facility. A user accesses the
16 central facility via the remote facility (p. 5, ll. 8-10; p. 6, l. 31 through p. 7, l.
17 3; p. 7, ll. 30-35; p. 9, l. 33 through p. 10, l. 7).

18 Saigh has a filing date of July 25, 1996 and is a continuation-in-part of
19 U.S. Patent Application No. 07/787,536 filed November 4, 1991 (hereinafter
20 “536 application”).

21 The '536 application does not disclose information regarding rentals.

22 Analysis

23 Claims 115, 116, 121, 122, and 140-143 have been rejected under
24 35 U.S.C. § 102(e) as being anticipated by Saigh. This application was filed
25 on March 29, 1996, and is a continuation-in-part application of the '309

1 application which was filed on June 29, 1994. As an initial matter, we must
2 determine whether the Appellant has shown that the '309 application
3 adequately supports the subject matter of the aforementioned claims. *See*
4 *Wagoner*, 463 F.2d at 1380.

5 The Appellant asserts that the '309 application, to which this
6 application claim priority, does provide support for multiple central
7 communications facilities (Appeal Brief 33-34; Reply Brief 1-2). We agree
8 with the Appellant.

9 The '309 application does provide written description support for
10 multiple central communications facilities, for example, at p. 5, ll. 8-10; p. 6,
11 l. 31 through p. 7, l. 3; p. 7, ll. 30-35; p. 9, l. 33 through p. 10, l. 7 of the
12 '309 application. While the Examiner is correct that Fig. 1 filed with the
13 '309 application does not show multiple central communications facilities,
14 all 35 U.S.C. § 112, ¶ 1, requires is that the specification describe the
15 invention in sufficient detail so that one skilled in the art can clearly
16 conclude that the inventor invented the claimed invention as of the filing
17 date sought. *In re Alonso*, 545 F.3d at 1019. *See also, Pandrol USA LP v.*
18 *Airboss Railway Products Inc.*, 424 F.3d 1161, 1165-1166 (Fed Cir. 2005)
19 (specification supported modification of drawing to include adhesive layer
20 12 between plate 10 and tie 1 to comply with 37 C.F.R. § 1.83(a)). The '309
21 application, even without the drawing, provides adequate written description
22 support for multiple central communications facilities.

23 Moreover, pages 9-30 of the Appeal Brief identifies extensive support
24 in the '309 application for the subject matter of the aforementioned claims.
25 Accordingly, absent an indication by the Examiner that the '309 application

1 does not provide specific support for any particular aspect of the
2 aforementioned claims, the effective filing date for the aforementioned
3 claims is the June 29, 1994 filing date of the ‘309 application.

4 Saigh has a filing date of July 25, 1996 and is a continuation of an
5 application filed December 30, 1994. Saigh is a continuation-in-part of the
6 ‘536 application, filed November 4, 1991. The ‘536 application does not
7 disclose information regarding rentals as recited in the aforementioned
8 claims, and as such is not relevant to the effective filing date of Saigh as it
9 relates to the subject application. *See In re Wertheim and Mishkin*, 209
10 USPQ at 565-566. However, the June 29, 1994 effective filing date of the
11 aforementioned claims antedates the December 30, 1994 effective date of
12 Saigh.

13 Accordingly, we will not sustain this rejection of claims 115, 116,
14 121, 122, and 140-143.

15

16 Rejection of claim 123 under 35 U.S.C. § 102(e) as being
17 anticipated by Gifford

18 The sole issue in regard to this rejection is whether the Appellant has
19 shown that the Examiner erred in asserting that Gifford discloses using
20 downloaded software to display or reproduce “information contained in a
21 transmitted hypermedia document” as recited in claim 123.

22 Findings of fact

23 Gifford discloses that the software architecture underlying the
24 particular preferred embodiment is based upon the conventions of the World
25 Wide Web including HTML, and that there are many techniques for

1 representing programs as data for purchase request 24 and purchase message
2 25 (col. 5, l. 63 through col. 6, l. 2; col. 4, l. 61 through col. 5, l. 6).

3 *Analysis*

4 The Appellant asserts that Gifford only discloses that the downloaded
5 program is only used to generate a “user purchase request and message,” and
6 not to “translate information contained in a transmitted hypermedia
7 document” as recited in claim 123 (Appeal Brief 35; Reply Brief 2). We
8 disagree with the Appellant.

9 Gifford discloses that “there are many techniques for representing
10 programs as data” for purchase request 24 and purchase message 25 at col.
11 5, l. 63 through col. 6, l. 2, and that “[t]he software architecture underlying
12 the particular preferred embodiment is based upon the conventions of the
13 World Wide Web” including HTML (col. 4, l. 61 through col. 5, l. 6).
14 Accordingly, Gifford discloses that the user purchase request 24 and user
15 purchase message 25 could be in HTML.

16 We will sustain this rejection of claim 123.

17

18 Rejection of claims 30-33, 36, 39-45, 47, 49, 51, 54, 57-64, 67, 79-
19 85, 87-90, 92, and 100 under 35 U.S.C. § 103(a) as being unpatentable
20 over AT&T in view of Dworkin

21 *Findings of Fact*

22 AT&T’s online service is a directory of directories (p. 1, Abstract).
23 AT&T discloses that before the introduction of CIX, 99% of CerfNet users
24 were researchers and academics, however, now 90% of users are
25 commercial. Users of the AT&T directory want to know how to contact

1 businesses and how to sell and use services that are available on it (p. 2, ¶
2 12-14).

3 A user of AT&T's word search may perform a word search on AT&T
4 to find out where information is located (p. 2, ¶ 1-5).

5 Dworkin discloses an automated system for locating and purchasing
6 goods or services sold by a plurality of vendors (Abstract).

7 Managers or suppliers may use a virtual bulletin board contained on
8 the system disclosed in Dworkin to inform users of new products and special
9 promotions (col. 9, ll. 36-46).

10 A user navigates the database 3 of Dworkin via multiple screen menus
11 (Figs. 3-4).

12 The specification discloses that a shopper may establish contact with
13 the central facility's equipment by helping themselves through a self-service
14 mode of a database which they can browse through for the goods and
15 services which interest them (p. 20, ll. 20-23).

16

17 Analysis

18 *Market and/or Sell Goods and/or Services*

19 The first issue in regard to this rejection is whether the Appellant
20 has shown that the Examiner erred in asserting that AT&T discloses an
21 apparatus to market and/or sell goods and/or services as recited in claims 30
22 and 44. We sustain the rejection of claim 30 and 44 for the reasons below.

23 The Appellant asserts that AT&T does not disclose a system used to
24 market and/or sell goods and/or services as recited in claims 30 and 44
25 because (1) the AT&T directory is a part of InterNIC which is about

1 scientific research and not commerce and (2) the directory itself is not used
2 to market and/or sells goods and/or services (Appeal Brief 36, 39; Reply
3 Brief 3, 5, 7). We disagree with the Appellant on this issue. Regardless of
4 whether AT&T is part of InterNIC, AT&T discloses that users of the AT&T
5 directory want to know how to contact businesses and how to sell and use
6 services that are available on it. Under a broadest reasonable interpretation,
7 using the AT&T directory to sell services meets the recitation of “market
8 and/or sell goods and/or services.” *See In re Am. Acad. Of Sci. Tech Ctr.*,
9 367 F.3d at 1364.

10 The Appellant also asserts that AT&T has users while the present
11 invention has customers (Appeal Brief 36). We once more disagree with
12 the Appellant on this issue. Under a broadest reasonable interpretation,
13 “users” can correspond to “customers” absent a specific definition of
14 customers set forth in the claim. *See Id.*; *CollegeNet, Inc.*, 418 F.3d at 1231.

15 The Appellant further asserts that the Examiner erred because some of
16 CerfNet users were researchers and academics (Reply Brief 3, 5, 7). We
17 disagree with the Appellant. The fact that some of CerfNet users were
18 researchers or academics is irrelevant. Claims 30 and 44 do not disclose that
19 the system must be used exclusively to market and/or sell goods and/or
20 services. *See Id.* As long as some of CerfNet’s users were commercial
21 users, the recitation of “market and/or sell goods and/or services” is met.

22 Moreover, we note that a preamble, such as the ones set forth in
23 claims 30 and 44 reciting apparatuses to market and/or sell goods and/or
24 services, is not limiting where a patentee defines a structurally complete

1 invention in the claim body and uses the preamble only to state a purpose or
2 intended use for the invention. *Catalina Mktg. Int'l, Inc.*, 289 F.3d at 808.

3

4 *Select and Contact*

5 The second issue in regard to this rejection is whether the Appellant
6 has shown that the Examiner erred in asserting that AT&T discloses at least
7 one of said computerized central communications facilities is adapted to
8 provide to said customer at said computerized remote facility a list of
9 computerized central communications facilities permitting said customer to
10 select and contact at least one other computerized central communications
11 facility as recited in claims 30 and 44.

12 The Appellant asserts that AT&T does not disclose permitting a
13 customer to select and contact at least one other computerized central
14 communications facility as recited in claims 30 and 44 (Appeal Brief 37, 39;
15 Reply Brief 3). We disagree with the Appellant.

16 The claim only recites *permitting* a customer to select and contact at
17 least one other computerized central communications facility. The claim
18 does not *require* the customer to select and contact at least one other
19 computerized central communications facility, through AT&T's software
20 architecture or otherwise, in order to meet the claim recitation. *See*
21 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231.

22 AT&T discloses a directory of directories, and a user performs a
23 word search on AT&T to find out where information is located, for example,
24 which directory. Once these results are returned, the user *may* use the
25 information to contact that directory so as to contact businesses listed in that

1 directory. Accordingly, once the word search results are returned, the user is
2 *permitted* to select and contact this directory using any suitable means, and
3 the claim recitation is satisfied under a broadest reasonable interpretation.
4 *See In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d at 1364. The fact that
5 AT&T may or may not *actually* disclose the user selecting and contacting
6 the directory, whether through the software architecture of AT&T or other
7 means, is irrelevant, as those recitations are not set forth in the claims.
8 *CollegeNet, Inc.*, 418 F.3d at 1231,

9

10 *Motivation*

11 The third issue in regard to this rejection is whether the Appellant has
12 shown that the Examiner erred in combining the single central facility of
13 Dworkin with the multiple central facilities of AT&T because there is no
14 motivation to combine the references.

15 The Appellant asserts that there is no motivation to combine the single
16 central facility of Dworkin with the multiple central facilities of AT&T
17 because the systems are fundamentally different (Appeal Brief 37, 39). We
18 disagree with the Appellant.

19 The test is not whether Dworkin and AT&T can or cannot be merged
20 wholesale, but whether one or ordinary skill in the art could combine certain
21 features from each reference with a proper motivation. *In re Keller*, 642
22 F.2d at 425. Both Dworkin and AT&T disclose buying and selling goods
23 and services over networks. Accordingly, Dworkin and AT&T appear to be
24 directed to the same technology that is amenable to substituting features
25 across references. Absent a showing by Appellant as to what *specific*

1 *technical aspects* of the single central facility of Dworkin and the multiple
2 central facilities of AT&T prevents the teachings of the references from
3 being combined in the manner suggested by the Examiner, this line of
4 reasoning is unconvincing.

5 Moreover, the Examiner has set forth a motivation on pages 9-10 of
6 the Office Action that “[i]t would have been obvious... to include the [the
7 information of interest stored in a database of Dworkin] within [the system
8 of AT&T] for the motivation of providing a system for locating and
9 purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-
10 65).” Absent any specific technical arguments as to why one or ordinary
11 skill in the art could not place the information of interest of Dworkin within
12 the system of AT&T, the motivation set forth by the Examiner is proper. *Id.*

13

14 *Non-Analogous Art*

15 The fourth issue in regard to this rejection is whether the Appellant
16 has shown that the Examiner erred in combining the single central facility of
17 Dworkin with the multiple central facilities of AT&T because Dworkin and
18 AT&T are non-analogous art.

19 The Appellant asserts that Dworkin and AT&T are non-analogous
20 art (Appeal Brief 37, 39). We disagree with the Appellant on this issue. A
21 reference is analogous art if it is either in the field of the applicant's
22 endeavor or reasonably pertinent to the particular problem with which the
23 inventor was concerned. *In re Oetiker*, 977 F.2d at 1447. AT&T, Dworkin
24 and the present invention are all directed to buying and selling goods over

1 networks. Accordingly, because they are all in the same field of endeavor,
2 they are all analogous art.

3

4 *Contact the Customer*

5 The fifth issue, however, in regard to this rejection is whether the
6 Appellant has shown that the Examiner erred in asserting that Dworkin
7 discloses “wherein at least one of said computerized central communications
8 facilities is further programmed to contact the customer and apprise said
9 customer of goods or services offered or any special offerings” as recited in
10 claim 32.

11 The Examiner asserts that Dworkin discloses a central facility
12 contacting a customer to apprise them of goods or services offered or special
13 offerings, as recited in claim 32, because Dworkin discloses a virtual bulletin
14 board on a computerized system where managers and suppliers can inform
15 users of new products and special promotions (Examiner’s Answer 5-6).
16 We disagree with the Examiner and agree with the Appellant’s arguments on
17 page 37 of the Appeal Brief and page 4 of the Reply Brief.

18 The virtual bulletin board in Dworkin can only provide information to
19 the customer if the customer accesses the virtual bulletin board, i.e., the
20 customer contacts the central facility. Even then, the customer is obtaining
21 the information from the virtual bulletin board, as no further action,
22 contacting or otherwise, is undertaken by any of the virtual bulletin board,
23 the managers or the suppliers.

24 For this reason, we will not sustain this rejection of claim 32.
25

1 *Competing Providers*

2 The sixth issue in regard to this rejection is whether the Appellant has
3 shown that the Examiner erred in asserting that AT&T discloses “wherein
4 said computerized central communications facility and each of said other
5 computerized central communications facilities are associated with
6 competing providers of goods and services” as recited in claim 33.

7 The Appellant asserts that the Examiner has failed to cite a specific
8 passage of AT&T which discloses that the computerized central
9 communications facilities are associated with competing providers as recited
10 in claim 33 (Appeal Brief 38; Reply Brief 4). We disagree with the
11 Appellant. AT&T discloses that it is a directory of directories. Each
12 directory is associated with a competing provider under a broadest
13 reasonable interpretation. *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d at
14 1364.

15 We will sustain this rejection of claim 33.

16

17 *Stopping Point in User Presentation*

18 The seventh issue in regard to this rejection is whether the Appellant
19 has shown that the Examiner erred in taking Official Notice of providing a
20 stopping point in a user presentation as recited in claims 36 and 51.

21 The Appellant asserts that the Official Notice of the “presentation
22 stopping point” recited in claims 36 and 51 was improper because this
23 limitation was found to be novel and an inventive step in another related
24 application (Appeal Brief 38, 40; Reply Brief 4, 6). We disagree with the
25 Appellant.

1 As an initial matter, Examiners are not bound to follow other
2 examiners' interpretations. *Dayco Products Inc. v. Total Containment Inc.*,
3 329 F.3d at 1368. Accordingly, the finding in the related application is
4 given no weight.

5 Moreover, Appellant has not provided any factual or technical
6 arguments as to why the Official Notice is improper, i.e., why a
7 "presentation stopping point" is not capable of instant and unquestionable
8 demonstration as being well-known. Absent such arguments, Appellant
9 cannot prevail. *In re Chevenard*, 139 F.2d 711, 713.

10 We will sustain this rejection of claims 36 and 51.

11

12 *Downloading Software*

13 The eighth issue in regard to this rejection is whether the Appellant
14 has shown that the Examiner erred in asserting that AT&T discloses a
15 processor programmed to download software from a computerized central
16 communications facility to a remote communications facility as recited in
17 claims 39, 41 and 58.

18 The Examiner asserts that AT&T's disclosure of downloading
19 information concerning the directory of directories to the user's computer
20 corresponds to downloading software from the computerized central
21 communications facilities as recited in claims 39, 41 and 58 (Examiner's
22 Answer 7, 9). We disagree with the Examiner and agree with the
23 Appellant's arguments on pages 38-40 of the Appeal Brief and page 4 of the
24 Reply Brief. Downloading *information* or *data*, as set forth in AT&T, does
25 not correspond to downloading *software*.

1 Accordingly, we will not sustain this rejection of claims 39, 41 and 58
2 under the Examiner's current rationale.

3

4 *Second Central Communications Facility*

5 The ninth issue in regard to this rejection is whether the Appellant has
6 shown that the Examiner erred in asserting that Dworkin discloses "a second
7 central communications facility having a database of information relating to
8 a second set of information relating to goods or services to provide upon
9 request" as recited in claim 44.

10 The Appellant asserts that Dworkin only discloses one database which
11 cannot correspond to a second central communications facility having a
12 database as recited in claim 44 (Appeal Brief 39). However, AT&T
13 discloses a directory of directories, each of which is a central
14 communications facility having a database. One cannot show non-
15 obviousness by attacking references individually where the rejections are
16 based on combinations of references. *In re Keller*, 642 F.2d at 425.

17 We will sustain this rejection of claim 44.

18

19 *Downloading Contract*

20 The tenth issue in regard to this rejection is whether the Appellant
21 has shown that the Examiner erred in asserting that Dworkin discloses "a
22 software application for assisting the central communications facility to
23 download a contract to the computerized remote location" as recited in claim
24 54.

1 The Examiner asserts that the sending of the transaction number of
2 an order to a user in Dworkin corresponds to a software application for
3 assisting the central communications facility to download a contract to a
4 computerized remote location as recited in claim 54 (Examiner's Answer 9).
5 We disagree with the Examiner and agree with the Appellant's arguments
6 on page 40 of the Appeal Brief and page 6 of the Reply Brief. A mere
7 transaction number, while an indication of the existence of a contract, is not
8 a contract in and of itself.

9 We will not sustain this rejection of claim 54.

10

11 *Browsing*

12 The eleventh issue in regard to this rejection is whether the Appellant
13 has shown that the Examiner erred in asserting that Dworkin discloses
14 "wherein said first central communications facility further enables said
15 customer to browse said first set of information relating to goods and
16 services" as recited in claim 79.

17 The Appellant asserts that navigating the screen menus of Dworkin
18 does not correspond to browsing as recited in claim 79 because the browsing
19 is not done over the Internet (Appeal Brief 41; Reply Brief 6-7). We
20 disagree with the Appellant. The definitions of browsing set forth by
21 Appellant on page 23, lines 20-23 of the Specification and page 41 of the
22 Appeal Brief both include scanning and viewing files in a computer
23 database. Dworkin discloses such "scanning and viewing" of files in
24 database 3 via view screen menus.

25 We will sustain this rejection of claim 79.

1

2 *Search First and Second Database*

3 The twelfth issue in regard to this rejection is whether the Appellant
4 has shown that the Examiner erred in asserting that Dworkin discloses
5 “enabling the remote facility to search said first database or said second
6 database” as recited in claim 81.

7 The Appellant asserts that Dworkin does not disclose “enabling the
8 remote facility to search said first database or said second database” as
9 recited in claim 81 because Dworkin only discloses one database (Appeal
10 Brief 41; Reply Brief 7). Claim 81 recites “enabling the remote facility to
11 search said first database *or* said second database” (emphasis added). As
12 long as the remote facility can search *at least one* of the first database and
13 the second database, such as database 3 in Dworkin, the claim recitation is
14 met. Moreover, AT&T discloses a directory of directories with multiple
15 databases.

16 We will sustain this rejection of claim 81.

17

18 *Other Claims*

19 The thirteenth issue in regard to this rejection is whether the Appellant
20 has shown that the Examiner erred in rejecting claims 31, 40, 42, 43, 45, 47,
21 49, 51, 57-64, 67, 80, 82-85, 87-90, 92 and 100.

22 In addition to a lack of motivation for combining AT&T and
23 Dworkin, which has been addressed above, the Appellant asserts that claims
24 31, 40, 42, 43, 45, 47, 49, 51, 57, 59-64, 67, 80, 82-85, 87-90, 92 and 100
25 are also allowable because they either (1) depend from an allowable claim,

1 or (2) are substantially similar to an allowable claim (Appeal Brief 39-42;
2 Reply Brief 5). We disagree with the Appellant. The rejection of the claims
3 from which these claims either depend or are substantially similar to has
4 been sustained. Accordingly, the rejection of these claims is also sustained.

5

6 Rejection of claims 50, 72, 77, 78, and 86 under 35 U.S.C. § 103(a)
7 as being unpatentable over AT&T in view of Dworkin and McCalley

8 The sole issue in regard to this rejection is whether the Appellant has
9 shown that the Examiner erred in rejecting claims 50, 72, 77, 78 and 86.

10 The Appellant asserts that claims 50, 72, 77, 78 and 86 are allowable
11 because they either (1) depend from an allowable claim, or (2) are
12 substantially similar to an allowable claim (Appeal Brief 42). We disagree
13 with the Appellant. The rejection of the claims from which these claims
14 either depend or are substantially similar to has been sustained.

15 Accordingly, the rejection of these claims is also sustained.

16

17 Rejection of claims 34, 35, 38, 48, 52, 53, 68, 69, 94, 95, 103, and
18 107 under 35 U.S.C. § 103(a) as being unpatentable over AT&T in view
19 of Dworkin and Filepp

20 *Findings of Fact*

21 Filepp discloses an interactive computer system network that enables
22 a user to display desired information, such as news, financial, and cultural
23 information, and perform desired transactional services, such as banking
24 and shopping, through any of a plurality of types of personal computers
25 (Abstract).

1 The applications on the interactive computer system network of
2 Filepp include text/graphic sessions, presentation data, videotext, sounds,
3 graphics data, pictorial codes and presentation media (col. 2, ll. 23-38; col.
4 18, ll. 40-55; col. 59, ll. 53-62; col. 65, ll. 50-64; col. 83, ll. 3-11; col. 90, l.
5 60 through col. 91, l. 13).

6

7 Analysis

8 *Motivation*

9 The first issue in regard to this rejection is whether the Appellant has
10 shown that the Examiner erred in combining the single central facility of
11 Filepp with the multiple central facilities of AT&T because there is no
12 motivation to combine the references.

13 The Appellant asserts that there is no motivation to combine the
14 single central facility of Filepp with the multiple central facilities of AT&T
15 because the systems are fundamentally different (Appeal Brief 42-44; Reply
16 Brief 8-9). We disagree with the Appellant.

17 The test is not whether Filepp and AT&T can or cannot be merged
18 wholesale, but whether one of ordinary skill in the art could combine certain
19 features from each reference with a proper motivation. *In re Keller*, 642
20 F.2d at 425. Both Filepp and AT&T disclose buying and selling goods and
21 services over networks. Accordingly, Filepp and AT&T appear to be
22 directed to the same technology that is amenable to substituting features
23 across references. Absent a showing by Appellant as to what *specific*
24 *technical aspects* of the single central facility of Filepp and the multiple
25 central facilities of AT&T prevents the references from being combined

1 in the manner suggested by the Examiner, this line or reasoning is
2 unconvincing.

3 Moreover, the Examiner has set forth a motivation on pages 19-20 of
4 the Office Action that “[i]t would have been obvious... to include [in at least
5 one computerized central communications facility] an audio communication
6 device for communication with said computerized remote communications
7 facility as disclosed by Filepp within AT&T and Dworkin for the motivation
8 of providing large numbers of users to applications containing interactive
9 text/audio/graphics (col. 2, lines 22-27).” Absent any specific technical
10 arguments as to why one or ordinary skill could not place the interactive
11 text/audio/graphics of Filepp within the systems of AT&T and Dworkin, the
12 motivation set forth by the Examiner is proper. *Id.*

13

14 *Non-Analogous Art*

15 The second issue in regard to this rejection is whether the Appellant
16 has shown that the Examiner erred in combining the single central facility
17 of Dworkin with the multiple central facilities of AT&T because Filepp and
18 AT&T are non-analogous art.

19 The Appellant asserts that Filepp and AT&T are non-analogous art
20 (Appeal Brief 42-44; Reply Brief 8-9). We disagree with the Appellant. A
21 reference is analogous art if it is either in the field of the applicant's
22 endeavor or reasonably pertinent to the particular problem with which the
23 inventor was concerned. *In re Oetiker*, 977 F.2d at 1447. AT&T, Filepp
24 and the present invention are all directed to buying and selling goods over

1 networks. Accordingly, because they are all in the same field of endeavor,
2 they are all analogous art.

3

4 *Audio or Video Presentations*

5 The third issue in regard to this rejection is whether the Appellant
6 has shown that the Examiner erred in asserting that Filepp discloses
7 computerized communications facilities adapted to provide information
8 relating to goods and services in the form of an audio or video presentation
9 as recited in claims 35, 48 and 68.

10 The Appellant asserts that Filepp's disclosure of audio signals and
11 videotext cannot correspond to audio or video presentations as recited in
12 claims 35, 48 and 68 (Appeal Brief 43-44; Reply Brief 7, 9-10). We
13 disagree with the Appellant.

14 As an initial matter, Appellant has not set forth any definition of audio
15 or video presentation in the claims that would exclude audio signals or
16 videotext. *See CollegeNet, Inc.*, 418 F.3d at 1231.

17 Moreover, Filepp additionally discloses applications on the interactive
18 computer system network that include text/graphic sessions, presentation
19 data, videotext, sounds, graphics data, pictorial codes and presentation media
20 (col. 2, ll. 23-38; col. 18, ll. 40-55; col. 59, ll. 53-62; col. 65, ll. 50-64; col.
21 83, ll. 3-11; col. 90, l. 60 through col. 91, l. 13). One or more of these
22 features constitute an audio or video presentation under a broadest
23 reasonable interpretation. *See In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d at
24 1364.

25 We will sustain this rejection of claims 35, 48 and 68.

1

2 *Auctioning Services, Housing Information/New Rejection*

3 The third issue in regard to this rejection is whether the Appellant has
4 shown that the Examiner erred in asserting that Filepp discloses auctioning
5 services as recited in claim 53, and information about the sale or financing
6 of housing as recited in claims 95 and 103.

7 The Appellant asserts that Filepp does not disclose wherein the
8 goods and services include auctioning services as recited in claim 53, and
9 providing information about the sale or financing of housing as recited in
10 claims 95 and 103 (Appeal Brief 44-45). Even assuming that we agree with
11 the Appellant, we nonetheless are of the opinion that claims 53, 95 and 103
12 merely constitute descriptive materials that are unrelated to the underlying
13 apparatus in any functional way. *See In re Ngai*, 367 F.3d at 1339.
14 Specifically, the underlying apparatus including central communications
15 facilities and remote communications facilities will not function differently
16 whether the information presented is for auctioning services or housing.

17 Therefore, we will sustain the rejection as it is directed to claims 53,
18 95 and 103. However, because our rationale differs from the rationale of
19 the Examiner, we denominate this a new rejection pursuant to 37 C.F.R.
20 § 41.50(b).

21

22 *Computerized Voice*

23 The fourth issue in regard to this rejection is whether the Appellant
24 has shown that the Examiner erred in asserting that the computerized voice
25 as recited in claim 69 is similar to the subject matter of claim 36.

1 The Examiner asserts that the computerized voice of claim 69 is
2 similar in scope to the subject matter of claim 36, and thus is rejected on the
3 same basis (Office Action 23). We disagree with the Examiner and agree
4 with the Appellant's arguments on page 44 of the Appeal Brief. Claim 36
5 recites "means for recording a presentation stopping point for future
6 reference," and is rejected as being obvious over a combination of AT&T,
7 Dworkin and Official Notice of a presentation stopping point. The
8 presentation stopping point of claim 36 is not similar in subject matter to the
9 computerized voice of claim 69.

10 We will not sustain this rejection of claim 69.

11

12 *Other Claims*

13 The fifth issue in regard to this rejection is whether the Appellant has
14 shown that the Examiner erred in rejecting claims 34, 38, 52, 94 and 107.

15 In addition to a lack of motivation for combining AT&T and Filepp,
16 which has been addressed above, the Appellant asserts that claims 34, 38,
17 52, 94 and 107 are also allowable because they either (1) depend from
18 an allowable claim, or (2) are substantially similar to an allowable claim
19 (Appeal Brief 42-44). We disagree with the Appellant. The rejection of the
20 claims from which these claims either depend or are substantially similar to
21 has been sustained. Accordingly, the rejection of these claims is also
22 sustained.

23

24 Rejection of claims 70-76 under 35 U.S.C. § 103(a) as being
25 unpatentable over AT&T in view of Dworkin and McCalley

1 *Select and Contact*

2 The first issue in regard to this rejection is whether the Appellant has
3 shown that the Examiner erred in asserting that AT&T discloses “said
4 central communications facility adapted to enable said customer to select
5 and contact at least one other central communications facility providing
6 information relating to goods and services” as recited in claim 70.

7 The Appellant asserts that AT&T does not disclose enabling a
8 customer to select and contact at least one other computerized central
9 communications facility as recited in claim 70 (Appeal Brief 45-46; Reply
10 Brief 10). We disagree with the Appellant.

11 The claim only recites *enabling* a customer to select and contact at
12 least one other computerized central communications facility. The claim
13 does not *require* the customer to select and contact at least one other
14 computerized central communications facility, through AT&T’s software
15 architecture or otherwise, in order to meet the claim recitation. *See*
16 *CollegeNet, Inc.*, 418 F.3d at 1231.

17 AT&T discloses a directory of directories, and a user performs a word
18 search on AT&T to find out where information is located, for example,
19 which directory. Once these results are returned, the user *may* use the
20 information to contact that directory so as to contact businesses listed in that
21 directory. Accordingly, once the word search results are returned, the user is
22 *enabled* to select and contact this directory using any suitable means, and the
23 claim recitation is satisfied under a broadest reasonable interpretation. *See*
24 *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d at 1364. The fact that AT&T
25 may or may not *actually* disclose the user selecting and contacting the

1 directory, whether through the software architecture of AT&T or other
2 means, is irrelevant, as those recitations are not set forth in the claims. *See*
3 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231.

4 We will sustain this rejection of claim 70 and claims 71-76 which
5 depend therefrom.

6

7 *Motivation*

8 The second issue in regard to this rejection is whether the Appellant
9 has shown that the Examiner erred in combining the single central facility
10 of Dworkin with the multiple central facilities of AT&T because there is no
11 motivation to combine the references (Appeal Brief 45-46). We disagree
12 with the Appellant for the same reasons as set forth above.

13

14 *Non-Analogous Art*

15 The third issue in regard to this rejection is whether the Appellant has
16 shown that the Examiner erred in combining the single central facility of
17 Dworkin with the multiple central facilities of AT&T because Dworkin and
18 AT&T are non-analogous art (Appeal Brief 45-46). We disagree with the
19 Appellant for the same reasons as set forth above.

20

21 Rejection of claims 93, 96-98, 101, and 104-106 under 35 U.S.C.
22 § 103(a) as being unpatentable over AT&T in view of Dworkin and
23 Examiner's Official Notice

24 *Employee Recruiting Information/New Rejection*

1 The first issue in regard to this rejection is whether the Appellant
2 has shown that the Examiner erred in taking Official Notice of providing
3 employee recruiting information as recited in claims 93 and 101.

4 The Appellant asserts that the Official Notice of the providing
5 employee recruiting information recited in claims 93 and 101 was improper
6 because the use of Official Notice is generally improper (Appeal Brief 46).
7 We disagree with the Appellant.

8 At no point in the prosecution of this application has Appellant
9 properly challenged the Official Notice by providing any factual or technical
10 arguments as to why the Official Notice is improper, i.e., why a providing
11 employee recruiting information is not capable of instant and unquestionable
12 demonstration as being well-known². Mere general assertions by the
13 Appellant that “the use of Official Notice itself is highly questionable” and
14 that because “this application is under final action such a use then of Official
15 Notice should be rare” do not constitute factual or technical arguments that
16 could properly challenge Official Notice (Appeal Brief 46). Factual or
17 technical arguments would address the substance of the Official Notice by
18 specifically referencing employee recruiting information. Absent such
19 factual or technical arguments, Appellant cannot prevail. *In re Chevenard*,
20 139 F.2d 711, 713.

21 Moreover, even assuming that we agree with the Appellant, we
22 nonetheless are of the opinion that claims 93 and 101 merely constitute
23 descriptive materials that are unrelated to the underlying apparatus in
24 any functional way. *See In re Ngai*, 367 F.3d at 1339. Specifically, the

² No proper challenge of Official Notice is set forth on either page 46 of the Appeal Brief or pages 20-21 of Supplemental Amendment filed July 6, 2004.

1 underlying apparatus including central communications facilities and remote
2 communications facilities will not function differently whether or not the
3 information provided concerns employee recruiting information.

4 Therefore, we will sustain the rejection as it is directed to claims 93
5 and 101. However, because our rationale differs from the rationale of the
6 Examiner, we denominate this a new rejection pursuant to 37 C.F.R.
7 § 41.50(b).

8

9 *Coupons*

10 The second issue in regard to this rejection is whether the Appellant
11 has shown that the Examiner erred in taking Official Notice of providing
12 coupons relating to goods and services as recited in claims 96, 97, 104 and
13 105.

14 The Appellant asserts that the Official Notice of the providing
15 coupons related to goods and services recited in claims 96, 97, 104 and 105
16 was improper because the use of Official Notice is generally improper
17 (Appeal Brief 46). We disagree with the Appellant.

18 At no point in the prosecution of this application has Appellant
19 properly challenged the Official Notice by providing any factual or technical
20 arguments as to why the Official Notice is improper, i.e., why a providing
21 coupons related to goods and services is not capable of instant and
22 unquestionable demonstration as being well-known³. Mere general
23 assertions by the Appellant that “the use of Official Notice itself is highly
24 questionable” and that because “this application is under final action such a

³ No proper challenge of Official Notice is set forth on either page 46 of the Appeal Brief or pages 20-21 of Supplemental Amendment filed July 6, 2004.

1 use then of Official Notice should be rare" do not constitute factual or
2 technical arguments that could properly challenge Official Notice (Appeal
3 Brief 46). Factual or technical arguments would address the substance of the
4 Official Notice by specifically referencing coupons related to goods and
5 services. Absent such factual or technical arguments, Appellant cannot
6 prevail. *In re Chevenard*, 139 F.2d 711, 713.

7 We will sustain this rejection of claims 96, 97, 104 and 105.

8

9 *Charging Fees for Information*

10 The third issue in regard to this rejection is whether the Appellant
11 has shown that the Examiner erred in taking Official Notice of charging
12 customers a fee for information as recited in claims 98 and 106.

13 The Appellant asserts that the Official Notice of charging customers a
14 fee for information recited in claims 98 and 106 was improper because the
15 use of Official Notice is generally improper (Appeal Brief 46). We disagree
16 with the Appellant.

17 At no point in the prosecution of this application has Appellant
18 properly challenged the Official Notice by providing any factual or technical
19 arguments as to why the Official Notice is improper, i.e., why charging
20 customers a fee for information is not capable of instant and unquestionable
21 demonstration as being well-known⁴. Mere general assertions by the
22 Appellant that "the use of Official Notice itself is highly questionable" and
23 that because "this application is under final action such a use then of Official
24 Notice should be rare" do not constitute factual or technical arguments that

⁴ No proper challenge of Official Notice is set forth on either page 46 of the Appeal Brief or pages 20-21 of Supplemental Amendment filed July 6, 2004.

1 could properly challenge Official Notice (Appeal Brief 46). Factual or
2 technical arguments would address the substance of the Official Notice by
3 specifically referencing charging customers a fee for information. Absent
4 such factual or technical arguments, Appellant cannot prevail. *In re*
5 *Chevenard*, 139 F.2d 711, 713.

6 We will sustain this rejection of claims 98 and 106.

7

8 Rejection of claims 108, 110-114 and 139 under 35 U.S.C. § 103(a)
9 as being unpatentable over Saigh in view of Lockwood

10 The sole issue in regard to this rejection is whether the Appellant
11 has shown that the Examiner erred in asserting that Saigh is prior art to the
12 subject matter of claims 108, 110-114 and 139 because parent Application
13 No. 08/268,309 filed June 29, 1994 does not provide written description
14 support for multiple central communications facilities (Appeal Brief 47-48;
15 Reply Brief 11-12). We agree with the Appellant for the same reasons as set
16 forth above.

17 We will not sustain this rejection of claims 108, 110-114 and 139.

18

19 Rejection of claim 109 under 35 U.S.C. § 103(a) as being
20 unpatentable over Saigh in view of Lockwood and Ferguson
21 Findings of Fact

22 The '309 application discloses auctioning services (p. 6, ll. 31-34).

23

24 Analysis
25 Saigh

1 The first issue in regard to this rejection is whether the Appellant has
2 shown that the Examiner erred in asserting that Saigh is prior art to the
3 subject matter of claim 109 because parent Application No. 08/268,309 filed
4 June 29, 1994 does not provide written description support for multiple
5 central communications facilities (Appeal Brief 48; Reply Brief 12). We
6 agree with the Appellant for the same reasons as set forth above.

7 We will not sustain this rejection of claim 109.

8

9 *Ferguson*

10 Even though we have sustained the rejection of claim 109, we will
11 continue our analysis of the rejection, particularly with respect to Ferguson,
12 given that subsequent claims depend on the outcome of such analysis.
13 Accordingly, we determine whether the Appellant has shown that the
14 Examiner erred in asserting that Ferguson is prior art to the subject matter of
15 claim 109 because parent Application No. 08/268,309 filed June 29, 1994
16 does not provide written description support for auctioning services.

17 Claim 109 has been rejected under 35 U.S.C. § 103(a) using
18 Ferguson. This application was filed on March 29, 1996, and is a
19 continuation-in-part application of the '309 application which was filed
20 on June 29, 1994. As an initial matter, we must determine whether the
21 Appellant has shown that the '309 application adequately supports the
22 subject matter of the aforementioned claims. *See Wagoner*, 463 F.2d at
23 1380.

1 The Appellant asserts that the '309 application, to which this
2 application claim priority, does provide support for auctioning services
3 (Appeal Brief 48; Reply Brief 12). We agree with the Appellant.

4 The '309 application does provide written description support for
5 auctioning services, for example, at p. 6, ll. 31-34 of the '309 application.
6 Accordingly, the effective filing date for claim 109 is the June 29, 1994
7 filing date of the '309 application.

8 Ferguson has a filing date of October 6, 1997, and is a continuation
9 of an application filed November 8, 1994. Accordingly, the June 29, 1994
10 effective filing date of the aforementioned claim antedates the November 8,
11 1994 effective date of Ferguson.

12 We will not sustain this rejection of claim 109.

13

14 Rejection of claim 139 under 35 U.S.C. § 103(a) as being
15 unpatentable over Saigh in view of Lockwood

16 The sole issue in regard to this rejection is whether the Appellant has
17 shown that the Examiner erred in asserting that Saigh is prior art to the
18 subject matter of claim 139 because parent Application No. 08/268,309 filed
19 June 29, 1994 does not provide written description support for multiple
20 central communications facilities (Appeal Brief 49; Reply Brief 13). We
21 agree with the Appellant for the same reasons as set forth above.

22 We will not sustain this rejection of claim 139.

23

24 Rejection of claim 124 under 35 U.S.C. § 103(a) as being
25 unpatentable over Saigh

1 The sole issue in regard to this rejection is whether the Appellant
2 has shown that the Examiner erred in asserting that Saigh is prior art to the
3 subject matter of claim 124 because parent Application No. 08/268,309 filed
4 June 29, 1994 does not provide written description support for multiple
5 central communications facilities (Appeal Brief 49; Reply Brief 13). We
6 agree with the Appellant for the same reasons as set forth above.

7 We will not sustain this rejection of claim 124.

8

9 Rejection of claim 125 under 35 U.S.C. § 103(a) as being
10 unpatentable over Gifford in view of Ferguson

11 The sole issue in regard to this rejection is whether the Appellant has
12 shown that the Examiner erred in asserting that Ferguson is prior art to the
13 subject matter of claim 125 because parent Application No. 08/268,309 filed
14 June 29, 1994 does not provide written description support for auctioning
15 services (Appeal Brief 49; Reply Brief 13). We agree with the Appellant for
16 the same reasons as set forth above.

17 We will not sustain this rejection of claim 125.

18

19 Rejection of claim 126 under 35 U.S.C. § 103(a) as being
20 unpatentable over Gifford in view of Lockwood

21 The sole issue in regard to this rejection is whether the Appellant has
22 shown that the Examiner erred in rejecting claim 126.

23 The Appellant asserts that claim 126 is allowable because it depends
24 from allowable independent claim 123 (Appeal Brief 49-50). We disagree

1 with the Appellant. The rejection of claim 123 has been sustained.

2 Accordingly, the rejection of claim 126 is also sustained.

3

4 Rejection of claims 127-129 under 35 U.S.C. § 103(a) as being
5 unpatentable over Gifford in view of Saigh

6 The sole issue in regard to this rejection is whether the Appellant
7 has shown that the Examiner erred in asserting that Saigh is prior art to the
8 subject matter of claims 127-129 because parent Application No. 08/268,309
9 filed June 29, 1994 does not provide written description support for multiple
10 central communications facilities (Appeal Brief 50-51; Reply Brief 14). We
11 agree with the Appellant for the same reasons as set forth above.

12 We will not sustain this rejection of claims 127-129.

13

14 Rejection of claims 130-132 and 135-137 under 35 U.S.C. § 103(a)
15 as being unpatentable over Saigh in view of InTouch

16 The sole issue in regard to this rejection is whether the Appellant has
17 shown that the Examiner erred in asserting that Saigh is prior art to the
18 subject matter of claims 130-132 and 135-137 because parent Application
19 No. 08/268,309 filed June 29, 1994 does not provide written description
20 support for multiple central communications facilities (Appeal Brief 51-53;
21 Reply Brief 15-16). We agree with the Appellant for the same reasons as set
22 forth above.

23 We will not sustain this rejection of claims 130-132 and 135-137.

24

1 Rejection of claim 133 under 35 U.S.C. § 103(a) as being
2 unpatentable over Saigh in view of InTouch and Ferguson

3 *Saigh*

4 The first issue in regard to this rejection is whether the Appellant
5 has shown that the Examiner erred in asserting that Saigh is prior art to the
6 subject matter of claim 133 because parent Application No. 08/268,309 filed
7 June 29, 1994 does not provide written description support for multiple
8 central communications facilities (Appeal Brief 53-54; Reply Brief 16). We
9 agree with the Appellant for the same reasons as set forth above.

10 We will not sustain this rejection of claim 133.

11 *Ferguson*

12 The second issue in regard to this rejection is whether the Appellant
13 has shown that the Examiner erred in asserting that Ferguson is prior art to
14 the subject matter of claim 133 because parent Application No. 08/268,309
15 filed June 29, 1994 does not provide written description support for
16 auctioning services (Appeal Brief 53-54; Reply Brief 16). We agree with
17 the Appellant for the same reasons as set forth above.

18 We will not sustain this rejection of claim 133.

19 Rejection of claim 134 under 35 U.S.C. § 103(a) as being
20 unpatentable over Saigh in view of InTouch and Lockwood

21 The sole issue in regard to this rejection is whether the Appellant
22 has shown that the Examiner erred in asserting that Saigh is prior art to the
23 subject matter of claim 134 because parent Application No. 08/268,309 filed

1 June 29, 1994 does not provide written description support for multiple
2 central communications facilities (Appeal Brief 54; Reply Brief 16-17). We
3 agree with the Appellant for the same reasons as set forth above.

4 We will not sustain this rejection of claim 134.

5

6 Rejection of claim 138 under 35 U.S.C. § 103(a) as being
7 unpatentable over Saigh in view of InTouch and Ferguson
8 *Saigh*

9 The first issue in regard to this rejection is whether the Appellant
10 has shown that the Examiner erred in asserting that Saigh is prior art to the
11 subject matter of claim 138 because parent Application No. 08/268,309 filed
12 June 29, 1994 does not provide written description support for multiple
13 central communications facilities (Appeal Brief 54; Reply Brief 17). We
14 agree with the Appellant for the same reasons as set forth above.

15 We will not sustain this rejection of claim 138.

16

17 *Ferguson*

18 The second issue in regard to this rejection is whether the Appellant
19 has shown that the Examiner erred in asserting that Ferguson is prior art to
20 the subject matter of claim 138 because parent Application No. 08/268,309
21 filed June 29, 1994 does not provide written description support for
22 auctioning services (Appeal Brief 54; Reply Brief 17). We agree with the
23 Appellant for the same reasons as set forth above.

24 We will not sustain this rejection of claim 138.

25

1 Rejection of claim 30 under the judicially created doctrine of
2 obviousness-type double patenting as being unpatentable over Wren in
3 view of AT&T and Dworkin

4 The sole issue in regard to this rejection is whether the Appellant has
5 shown that the Examiner erred in asserting that claim 30 was unpatentable
6 for obviousness-type double patenting over claims 1-5 of Wren in view of
7 AT&T and Dworkin.

8 The Appellant asserts that the obviousness-type double patenting
9 rejection of claim 30 is improper because claim 30 includes aspects that are
10 not present in claims 1-5 of Wren (Appeal Brief 54-55; Reply Brief 17). We
11 disagree with the Appellant.

12 Appellant appears to be confusing *statutory* double patenting and
13 *obviousness-type* double patenting. Under *statutory* double patenting,
14 Appellant is correct that the only claims that may be rejected are claims that
15 are identical. Claim 30 of this application and claims 1-5 of Wren are not
16 identical. Under *obviousness-type* double patenting, however, the claims are
17 not identical because the application claim includes an aspect that is not
18 present in the patent claim. In that case, another reference including the
19 missing aspect is identified and combined with the patent claim to render the
20 application claim obvious. Such is the case here.

21 The Examiner is conceding that claim 1 of Wren does not include
22 certain aspects of claim 30. However, the Examiner is then asserting that
23 either AT&T or Dworkin discloses those aspects, and then is combining
24 claim 1 of Wren with those aspects of AT&T and Dworkin to render claim
25 30 obvious (Office Action 41-43). As the Examiner has established a proper

1 *prima facie* case of obviousness, and Appellant has not set forth any
2 arguments as to why the combination is improper, we will sustain this
3 rejection. *See In re Keller*, 642 F.2d at 425.

4 We will sustain this rejection of claim 30.

5

6 Rejection of claims 108-114 and 130-143 under the judicially
7 created doctrine of obviousness-type double patenting as being
8 unpatentable over Wren in view of Saigh, Ferguson, InTouch, and
9 Lockwood

10 The sole issue in regard to this rejection is whether the Appellant has
11 shown that the Examiner erred in asserting that claims 108-114 and 130-143
12 were unpatentable for obviousness-type double patenting over claims 1-5 of
13 Wren in view of Saigh, Ferguson, Intouch and Lockwood.

14 The Appellant asserts that the obviousness-type double patenting
15 rejection of claims 108-114 and 130-143 is improper because claims 108,
16 130, 138 and 140 include aspects that are not present in claims 1-5 of Wren
17 (Appeal Brief 55-56; Reply Brief 18). Again, Appellant appears to be
18 confusing *statutory* double patenting and *obviousness-type* double patenting.
19 Claims 108-114 and 130-143 have been rejected under *obviousness-type*
20 double patenting.

21 The Examiner concedes that claims 1-5 of Wren do not include
22 certain aspects of claims 108-114 and 130-143 (Office Action 43-44). The
23 Examiner then asserts that at least one of Saigh, Ferguson, InTouch and
24 Lockwood discloses those aspects. However, the Examiner only sets forth
25 a rationale for combining Saigh and claims 1-5 of Wren (Office Action 43-

1 44). As Saigh is not prior art to claims 108-114 and 130-143 for the reasons
2 set forth above, this rejection is no longer effective.

3 The Examiner attempts to remedy this by citing Dworkin as allegedly
4 remedying the deficiencies of claims 1-5 of Wren (Examiner's Answer 21-
5 22). However, Dworkin was not originally cited for this rejection and thus
6 we will not consider it. *See In re Hoch*, 428 F.2d at 1342 n. 3. *Compare In*
7 *re Cowles*, 156 F.2d at 551; *In re Christensen et al.*, 166 F.2d at 825.

8 Moreover, the Examiner has not set forth a rationale as to how claims 1-5 of
9 Wren and Dworkin render obvious the aspects of claims 108, 130, 138 and
10 140 cited by Appellant at pages 55-56 of the Appeal Brief. *See In re Keller*,
11 642 F.2d at 425. Pages 21-22 of the Examiner's Answer only assert that
12 Dworkin discloses periodically updating a database, which is not recited
13 in any of the aspects of claims 108, 130, 138 and 140 cited by Appellant.

14 We will not sustain this rejection of claims 108-114 and 130-143
15 under the Examiner's current rationale.

16

17 CONCLUSIONS OF LAW

18 The Appellant has failed to show that the Examiner erred in rejecting
19 claims 30, 31, 33-36, 38, 40, 42-45, 47-53, 57, 59-68, 70-107, 123 and 126.

20 The Appellant has shown that the Examiner erred in rejecting claims
21 32, 39, 41, 54, 58, 69, 108-116, 121, 122, 124, 125 and 127-143.

22 Claims 117-120 are directed to non-elected species, were withdrawn
23 from consideration in the final Office Action mailed July 18, 2005, and thus
24 have not been considered in this opinion.

1 The Appellant did show that the Examiner erred in asserting that
2 Saigh is prior art to the subject matter of claims 108-116, 121, 122, 124 and
3 127-143 because parent Application No. 08/268,309 filed June 29, 1994
4 does not provide written description support for multiple central
5 communications facilities.

6 The Appellant did not show that the Examiner erred in asserting
7 that Gifford discloses using downloaded software to display or reproduce
8 “information contained in a transmitted hypermedia document” as recited
9 in claim 123.

10 The Appellant did not show that the Examiner erred in asserting that
11 AT&T discloses an apparatus to market and/or sell goods and/or services as
12 recited in claims 30 and 44.

13 The Appellant did not show that the Examiner erred in asserting that
14 AT&T discloses at least one of said computerized central communications
15 facilities is adapted to provide to said customer at said computerized remote
16 facility a list of computerized central communications facilities permitting
17 said customer to select and contact at least one other computerized central
18 communications facility as recited in claims 30 and 44.

19 The Appellant did not show that the Examiner erred in combining the
20 single central facility of Dworkin with the multiple central facilities of
21 AT&T because (1) there is no motivation to combine the references and (2)
22 Dworkin and AT&T are non-analogous art.

23 The Appellant did show that the Examiner erred in asserting that
24 Dworkin discloses “wherein at least one of said computerized central
25 communications facilities is further programmed to contact the customer and

1 apprise said customer of goods or services offered or any special offerings”
2 as recited in claim 32.

3 The Appellant did not show that the Examiner erred in asserting that
4 AT&T discloses “wherein said computerized central communications
5 facility and each of said other computerized central communications
6 facilities are associated with competing providers of goods and services” as
7 recited in claim 33.

8 The Appellant did not show that the Examiner erred in taking Official
9 Notice of providing a stopping point in a user presentation as recited in
10 claims 36 and 51.

11 The Appellant did show that the Examiner erred in asserting that
12 AT&T discloses a processor programmed to download software from a
13 computerized central communications facility to a remote communications
14 facility as recited in claims 39, 41 and 58.

15 The Appellant did not show that the Examiner erred in asserting that
16 Dworkin discloses “a second central communications facility having a
17 database of information relating to a second set of information relating to
18 goods or services to provide upon request” as recited in claim 44.

19 The Appellant did show that the Examiner erred in asserting that
20 Dworkin discloses “a software application for assisting the central
21 communications facility to download a contract to the computerized remote
22 location” as recited in claim 54.

23 The Appellant did not show that the Examiner erred in asserting that
24 Dworkin discloses “wherein said first central communications facility

1 further enables said customer to browse said first set of information relating
2 to goods and services" as recited in claim 79.

3 The Appellant did not show that the Examiner erred in asserting that
4 Dworkin discloses "enabling the remote facility to search said first database
5 or said second database" as recited in claim 81.

6 The Appellant did not show that the Examiner erred in rejecting
7 claims 31, 40, 42, 43, 45, 47, 49, 51, 57-64, 67, 80, 82-85, 87-90, 92 and
8 100.

9 The Appellant did not show that the Examiner erred in rejecting
10 claims 50, 72, 77, 78 and 86.

11 The Appellant did not show that the Examiner erred in combining the
12 single central facility of Filepp with the multiple central facilities of AT&T
13 because (1) there is no motivation to combine the references and (2) Filepp
14 and AT&T are non-analogous art.

15 The Appellant did not show that the Examiner erred in asserting that
16 Filepp discloses that a computerized communications facility is adapted to
17 provide information relating to goods and services in the form of an audio or
18 video presentation as recited in claims 35, 48 and 68.

19 The Appellant did show that the Examiner erred in asserting that
20 Filepp discloses auctioning services as recited in claim 53 and information
21 about the sale or financing of housing as recited in claims 95 and 103?

22 The Appellant did show that the Examiner erred in asserting that the
23 computerized voice as recited in claim 69 is similar to the subject matter of
24 claim 36.

1 The Appellant did not show that the Examiner erred in rejecting
2 claims 34, 38, 52, 94 and 107.

3 The Appellant did not show that the Examiner erred in asserting that
4 AT&T discloses “said central communications facility adapted to enable
5 said customer to select and contact at least one other central communications
6 facility providing information relating to goods and services” as recited in
7 claim 70.

8 The Appellant did show the Examiner erred in taking Official Notice
9 of providing employee recruiting information as recited in claims 93 and
10 101.

11 The Appellant did not show that the Examiner erred in taking Official
12 Notice of providing coupons relating to goods and services as recited in
13 claims 96, 97, 104 and 105.

14 The Appellant did not show that the Examiner erred in taking Official
15 Notice of charging customers a fee for information as recited in claims 98
16 and 106.

17 The Appellant did show that the Examiner erred in asserting that
18 Ferguson is prior art to the subject matter of claims 109, 125, 133, 134 and
19 138 because parent Application No. 08/268,309 filed June 29, 1994 does not
20 provide written description support for auctioning services.

21 The Appellant did not show that the Examiner erred in rejecting claim
22 126.

23 The Appellant did not show that the Examiner erred in asserting that
24 claim 30 was unpatentable for obviousness-type double patenting over
25 claims 1-5 of Wren in view of AT&T and Dworkin.

1 The Appellant did show the Examiner erred in asserting that claims
2 108-114 and 130-143 were unpatentable for obviousness-type double
3 patenting over claims 1-5 of Wren in view of Saigh, Ferguson, Intouch and
4 Lockwood.

5

DECISION

7 The decision of the Examiner to reject claims 30, 31, 33-36, 38, 40,
8 42-45, 47-53, 57, 59-68, 70-107, 123 and 126 is affirmed. The decision of
9 the Examiner to reject claims 32, 39, 41, 54, 58, 69, 108-116, 121, 122, 124,
10 125 and 127-143 is reversed. Claims 117-120 are still withdrawn from
11 consideration.

12 We have entered new two new ground of rejection under 37 C.F.R.
13 § 41.50(b): (1) claims 53, 95 and 103 are rejected under 35 U.S.C. § 103(a)
14 as being unpatentable over AT&T, Dworkin and Filepp; and (2) claims 93
15 and 101 are rejected under 35 U.S.C. § 103(a) as being unpatentable over
16 AT&T and Dworkin.

17 37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection
18 pursuant to this paragraph shall not be considered final for judicial review.”

19 Regarding the new ground of rejection, Appellant must, WITHIN
20 TWO MONTHS FROM THE DATE OF THE DECISION, exercise one of
21 the following options with respect to the new ground of rejection, in order to
22 avoid termination of the appeal as to the rejected claims:

23 (1) *Reopen prosecution.* Submit an appropriate amendment of the
24 claims so rejected or new evidence relating to the claims so rejected,
25 or both, and have the matter reconsidered by the examiner, in which
26 event the proceeding will be remanded to the examiner. . . [; or]

1 (2) *Request rehearing*. Request that the proceeding be reheard under
2 § 41.52 by the Board upon the same record. . . .

3 No time period for taking any subsequent action in connection
4 with this appeal may be extended under 37 C.F.R. § 1.136(a).

5

6 AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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9

10

11 JRG

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16 Waterloo, IL 62298